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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,592	07/08/2003	Louis Johan Wagenaar	BAY-001.01	8286
25181	7590	12/06/2007		
FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110			EXAMINER AZPURU, CARLOS A	
			ART UNIT	PAPER NUMBER
			1615	
			MAIL DATE	DELIVERY MODE
			12/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/615,592	Applicant(s) WAGENAAR, LOUIS JOHAN	
	Examiner Carlos A. Azpuru	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,18,20,21,23,24,36-40 and 43-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,18,20,24,36-39,44,45,47,51,58 and 62 is/are rejected.
- 7) ☒ Claim(s) 21,23,40,43,46,48-50,52-57, 59-61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10012007</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the request for continued examination filed 10/01/2007. An IDS was filed on 10/01/2007. A signed declaration from the translator was also filed on 10/01/2007.

The following rejection is maintained in this action:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 18, 20,24, 36, 37, 38, 39, 44-45, 47, 54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Siccaprotect™.

Siccaprotect™ is disclosed as containing dexpanthenol and is used in eye drops compositions for contact lenses (see D1-D4). The composition appears to also contain

polyvinyl alcohol and benzalkonium chloride as a preservative used against gram-positive and gram-negative bacteria (see D1 and D2). The percentage of dexpanthenol is higher than 1% (see newly cited Siccaprotect material from UesaPharm). The composition is clearly anticipated. The methods of disinfection, storing and cleaning contact lenses are therefore also clearly anticipated.

Response to Arguments

Applicant's arguments filed 10/01/2007 have been fully considered but they are not persuasive.

As noted in the declaration, the translation should have read "with hard contact lenses", rather than "on hard contact lenses". This new translation makes the rejection over Siccaprotect even stronger since it is clear that the solution can be applied separately from the contact lenses. In other words, application may be before, during or after the wearer places the contact lenses in his/her eyes.

Regarding claim 3, applicant states that the reference does not teach that the solution can be added to the contact outside the eye. However, the new translation seems to bolster what is inherent to administration of such contacts to dry eyes. Many users add the solution to the contact before placing it on the eye. The language "with" seems to leave this open, and is even more inclusive of this method than the previous "upon". The rejection is therefore maintained.

With regard to the kit claims such as 18, these claims are read as composition claims. As such, the reference clearly sets out a "kit" comprising the solution and contact lenses.

With regard to claim 44, placing the contact in a solution of dexpanthenol reads on placing the contacts in an eye that has the dexpanthenol. Claim limitations do not distinguish from the reference teachings in that any solution containing dexpanthenol, including those containing lacrimal fluids would read on it.

Regarding claim 45, applicant states that Siccprotect would not effectively clean or rinse the contact lens when it is in the eye. No data has been provided to support this statement. As such, rejection of this claim is maintained.

Claims 46, 53, 60 and 61 were not rejected for the reasons cited by applicant.

For the reasons above, the rejection over the tradenamed composition, Siccprotect is maintained in this action.

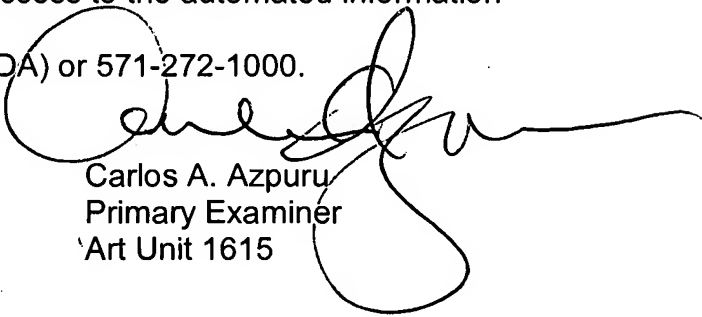
Claims 21,23,40,43,46,48-50,52-57, 59-61 are objected to as dependent upon a rejected base claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Azpuru whose telephone number is (571) 272-0588. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Carlos A. Azpuru
Primary Examiner
Art Unit 1615

caz